

REMARKS

Claims 1-8, 19, 20, 31, 34 and 37-44 are pending in the present application. Claims 1, 19, 20, 39 and 41 are independent. Reconsideration of this application in view of the following remarks is respectfully requested.

Suspension of Action Under 37 C.F.R. § 1.103

This Reply has been submitted concurrently with the filing of a Request for Continued Examination (RCE) in order to satisfy the submission requirement of the RCE. However, a suspension of action of three (3) months under 37 C.F.R. § 1.103(c) has also been filed concurrently herewith. A Supplemental Amendment will follow on or before June 11, 2009.

Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1, 8, 19, 20, 31, 34, 39 and 43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Todd et al., U.S. Patent No. 5,639,010. Claims 1-8, 19, 20, 31, 34 and 37-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cutting et al., U.S. Patent No. 5,638,597 in view of Osamu, JP 2-200376. These rejections are respectfully traversed.

The present invention is directed to a method of applying viscous medium on a substrate. Each of independent claims 1, 19, 20, 39 and 41 recite a combination of elements including the recitation "wherein the add-on jetting is non-contact dispensing and the add-on jetting viscous medium is still in viscous form during the add-on jetting" or "wherein the jetting of additional viscous medium is non-contact dispensing and the additional viscous medium is still in viscous form during the jetting of additional viscous medium." Claim 41 specifically recites that the add-on jetting viscous medium is solder paste.

In addition, independent claim 1 recites "add-on jetting of predetermined additional amounts of viscous medium on predetermined positions on the screen printed substrate," claim 39 recites "add-on jetting of individual droplets of viscous medium on predetermined positions on the screen printed substrate" and claim 41 recites add-on jetting of solder paste on predetermined positions on the screen printed substrate."

Applicants respectfully submit that the references relied on by the Examiner fail to teach or suggest the present invention as recited in the independent claims.

DECLARATION UNDER 37 C.F.R. § 1.132

A Declaration under 37 C.F.R. § 1.132 was submitted with the reply on February 11, 2009. In the Examiner's Advisory Action, the Examiner did not indicate whether the Declaration was entered and considered. Since a Request for Continued Examination has been filed, it is requested that the Examiner consider this declaration and indicate such in the next official communication **after the above-noted Supplemental Amendment has been received and the time of the Suspension of Action under 37 C.F.R. § 1.103(c) has expired, i.e. June 11, 2009.**

In the Examiner's Advisory Action dated March 9, 2009, the Examiner states the following:

...the Examiner directs Applicants to Fig. 1 and Col. 9, lines 3-5 of the US Patent 5,364,011 to Baker et al (the Examiner will cite this prior art reference as an intrinsic evidence in the future Office Action) which discloses the non-contact dispensing of adhesive material same as disclosed by Todd et al. (i.e. a drop of adhesive is dispensed means the droplet of adhesive is dropped as shown in Fig. 1).

The Examiner's rejection in view of the Todd et al. reference is one of anticipation under 35 U.S.C. § 102(b). Therefore, the Examiner must be relying on the Baker et al. reference to show that it is inherent in Todd et al. that non-contact dispensing is being used by Todd et al. If this is the case, Applicants completely disagree with the Examiner.

As indicated in the Declaration under 37 C.F.R. § 1.132 filed with the response of February 11, 2009, Todd et al. does not disclose non-contact dispensing. The comments from the Examiner that since Todd et al. discloses a drop of adhesive, Todd et al. discloses non-contact dispensing are completely without basis. In order for inherency to be shown, the reference must necessarily, not possibly disclose a particular limitation of the claim. The reliance on Baker et al. does not change the fact that Todd et al. does not inherently disclose non-contact dispensing.

Therefore, the Examiner's rejection under 35 U.S.C. § 102(b) in view of Todd et al. is improper and should be withdrawn.

The Examiner's only possible position with regard to the Baker et al. reference would be that Baker et al. provides a suggestion to one having ordinary skill in the art that non-contact dispensing should be used in Todd et al. However, as mentioned above, the present rejection in view of Todd et al. is one of anticipation under 35 U.S.C. § 102(b). Therefore, obviousness is irrelevant to this rejection and therefore, the Examiner should withdraw the rejection and provide a new Office Action.

With regard to the Examiner's comments regarding the Osamu reference and the "predetermined" aspect of the present invention, Applicants will address these comments in the Supplemental Amendment, which will be filed in the near future.

In view of the above amendments and remarks, Applicants respectfully submit that claims 1-8, 19, 20, 31, 34 and 37-44 clearly define the present invention over the references relied on by the Examiner. Accordingly, reconsideration and withdrawal of the Examiner's rejections under 35 U.S.C. §§ 102 and 103 are respectfully requested.

CONCLUSION

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.


It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact Paul C. Lewis, Registration No. 43,368 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

Paul C. Lewis
Registration No.: 43,368
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant